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Election/EXT.(1)/#9
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PATENT
Attorney Docket No. 207198

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 10 2002

In re Application of:

Saito et al.

Group Art Unit: 1644

TECH CENTER 1600/2900

Application No. 09/706,301

Examiner: G. R. Ewoldt

Filed: November 3, 2000

For: OIL ADJUVANT VACCINE

RESPONSE TO OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated January 25, 2002, please consider the following remarks.

REMARKS

The Election Of Species Requirement

The Office Action sets forth a species election requirement and requests that applicants elect a specific emulsifier and a specific oil component. According to the Office Action, different emulsifiers and oil components comprise different chemical and immunological properties and could elicit different responses. Therefore, the Office maintains that the species are independent and patentably distinct.

Election Of Species With Traverse

In response to the species election, applicants elect, with traverse, an oil component (A) that comprises a fatty acid ester, an emulsifier (B) that comprises a partial ester of polyhydric alcohol and a fatty acid, and an emulsifier (D) that comprises a non-ionic surfactant with a polyoxyethylene chain. Claims 1-15 are generic to (i.e., encompass) the elected species.

Discussion Of Election Of Species Requirement

There are two criteria for proper requirement for restriction (including an election of species) between patentably distinct inventions (or species). The criteria are as follows:

- (i) the inventions (or species) must be independent or distinct as claimed, AND
- (ii) there must be a serious burden on the Examiner if restriction is not required.

M.P.E.P. § 803.

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"If the search and examination of an entire application can be made without serious burden, the Examiner *must* examine it on the merits, *even though it includes claims to distinct or independent inventions*" (M.P.E.P. § 803, emphasis added). Significantly, M.P.E.P. § 802.02 clarifies that the term "restriction" in M.P.E.P. § 803 includes election of species requirements. As such, both of these criteria (i) and (ii) must be met for an election of species requirement to be proper.

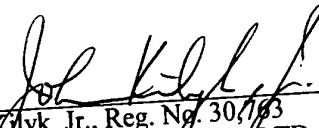
In the present patent application, the Office Action has failed to meet the two criteria for a proper election of species requirement by not asserting, let alone demonstrating, that there would be a serious burden on the Examiner if election of species were not required. In the absence of an undue burden, all of the species and claims must be examined together.

Accordingly, applicants respectfully request that the election of species requirement be withdrawn.

Conclusion

While applicants have elected the above species in response to the Office Action, the election merely is intended to aid the Examiner in the search and examination of the instant patent application. The election is by no means indicative of the applicants' willingness to ultimately limit the invention to these species. Applicants understand that, consistent with an election of species requirement, other species will be considered within the "generic" claims encompassing the elected species upon an indication of allowable subject matter with respect to the elected species. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: March 25, 2002

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I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: March 25, 2002

John Klyh.

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